

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/17/10 has been entered.

### ***Response to Amendment***

This office action is in response to amendment filed on 6/17/10. Claims 1, 10, and 14 have been amended.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-12, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the subject matter of the claim is indefinite because it is unclear how the first transition, the second transition, and activation of the first step fits

in with the first, second, and third steps. The claim is directed to a method but does not contain any logical flow. These issues were discussed in an interview with Attorney Mark Bergner on 8/11/11. The Examiner's broadest reasonable interpretation will be used to examine the claims with respect to prior art.

Regarding claims 3-9, the limitations are rejected because they do not render claim 1 definite.

Regarding claim 10 and 14, the limitations are rejected as applied to claim 1.

Regarding claims 11 and 12, the limitations are rejected because they do not render claim 10 definite.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Kirkpatrick et al. (US 7,373,144) (hereinafter Kirkpatrick).

Regarding claim 1, Ouzounidis teaches a method for informing an application server (presence server) whether or not a mobile subscriber is present on a mobile telecommunication network, the method comprising:

a first step for sending a first signal distinctive of the mobile subscriber to the mobile telecommunication network (SMS-C), intended for the mobile subscriber (an SMS message is sent from the presence to the SMS-C);

a second step for determining a present or not present binary state according to a reaction of the mobile telecommunication network to said first signal (SMS-C determines if message is delivered to the mobile telephone); and

a third step for communicating to the application server the state determined in the second step (SMS-C sends an acknowledgement back to the presence server of where the mobile telephone is available);

wherein:

a first transition enabled by a reaction of the mobile telecommunication network indicating that the message is delivered (SMS-C acknowledges to the presence server that the mobile telephone is available), respectively a second transition enabled by an expiry of a time delay (specified time limit) without reaction from the mobile telecommunication network, activates the second step that determines the present, respectively not present state of the mobile subscriber (the SMS-C determines that the

mobile telephone is unavailable if the message is not delivered within the specified time limit) (column 7, lines 5-30).

However, Ouzounidis does not explicitly teach setting said time delay as a function of the present or not present state determined in the second step. Kirkpatrick discloses a system and method for automatically providing user status in a messaging service (title). Kirkpatrick teaches positioning a time delay (T2) that is a function of the present or not present state (expiry of T1 designates a "not present" state of the wireless device) (column 5, lines 10-49). Thus, Kirkpatrick broadly teaches the setting of a time delay based upon an initial presence determination. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ouzounidis to include an additional delay period when waiting for the message delivered acknowledgment, as taught by Kirkpatrick, in order to use the expiry of the first specified time limit to indicate to the originator that the recipient is out of coverage or that the communication will be made when the recipient becomes available. This modification allows enhances the user friendliness of the system in that the originator will know why a communication is unsuccessful.

Regarding claim 4, Ouzounidis teaches the first step is activated during an activation of the second step by positioning a time delay that is a function of the present or not present state determined in the second step (column 7, lines 5-30).

Regarding claim 5, Ouzounidis teaches a step of a wait time activated when the second step determines the present state so as to activate the first step after expiry of the wait time (paragraph 134).

Regarding claim 6, Ouzounidis teaches said first signal consists of a telecommunication network node interrogation of the present or not present state of the mobile subscriber (SMS-C interrogates availability with SMS); and

the reaction of the mobile telecommunication network includes a response of the telecommunication network node on the present or not present state of the mobile subscriber (SMS-C responds to request of presence server with acknowledgment) (column 7, lines 5-30);

Regarding claim 7, Ouzounidis teaches said first signal consists of a positioning of a detection point on a telecommunication network node relating to any modification of the present or not present state of the mobile subscriber (SMS is used to detect availability of the mobile telephone); and

the reaction of the mobile telecommunication network includes a notification of the telecommunication network node (SMS-C) relating to each modification of the present or not present state of the mobile subscriber (SMS-C acknowledges to presence server whether the mobile telephone is available or not) (column 7, lines 5-30).

Regarding claim 8, Ouzounidis teaches an activation of the third step communicating the present state to the application server is followed by an activation of the third step communicating the not present state to the application server when the state determined in the second step passes from present to not present (the SMS-C reports to the presence server that the mobile telephone is unavailable) (column 7, lines 5-30).

Regarding claim 9, Ouzounidis teaches an activation of the third step results from a transition enabled by a request originating from the server to request the state of the mobile subscriber (message is sent from presence server to the SMS-C to determine availability) (column 7, lines 5-30).

Regarding claim 10, the limitations are rejected as applied to claim 1.

Regarding claim 11, Ouzounidis teaches the first means is arranged to send the first signal in the form of a short message intended for the mobile subscriber (SMS-C sends SMS to mobile telephone); and

the second means is arranged to determine the present state when the short message is delivered and to determine the not present state when the short message is not delivered after expiry of a preset time delay (SMS-C determines that the mobile telephone is unavailable when the message is not delivered in a specified time period) (column 7, lines 5-30).

Regarding claim 12, Ouzounidis teaches the first means is arranged to send said first signal at regular time intervals that depend on the present or not present state of the mobile subscriber (SMS is used to determine if the availability of the mobile telephone) (column 7, lines 5-30).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Kirkpatrick et al. (US 7,373,144) (hereinafter Kirkpatrick) as applied to claim 1, and further in view of Ganor (US 2004/0219908).

The combination of Ouzounidis and Kirkpatrick teaches said first signal is a short message sent to the mobile telecommunication network intended for the mobile subscriber (column 7, lines 5-30), but does not explicitly teach positioning a data coding scheme parameter in a header of the short message at a value that has the effect of commanding the mobile receiving the message to discard the content of the message and to deactivate a message received indication on the mobile. Ganor discloses a method and system for detecting availability of a wireless device (title). Ganor teaches positioning a data coding scheme parameter in a header of the short message (SMS0) at a value that has the effect of commanding the mobile receiving the message to discard the content of the message and to deactivate a message received indication on the mobile (paragraphs 10-12). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ouzounidis and Kirkpatrick to send a SMS with a header which is not indicated to the user of the handset, as taught by Ganor, in order to prevent the determination of availability to interfere with the user and so that the message can be automatically discarded.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Kirkpatrick et al. (US 7,373,144) (hereinafter Kirkpatrick) as applied to claim 4, and further in view of O'Neil et al. (US 7,127,232) (hereinafter O'Neil).

The combination of Ouzounidis and Kirkpatrick teaches the limitations of claim 4 and a step of a wait time activated when the second step determines the present state (column 7, lines 5-30), but does not explicitly teach activating the first step after expiry of the wait time. O'Neil discloses multiple access internet portal revenue sharing. O'Neil teaches that if a phone can not be reached by a SMSC the message will be retry transmission (column 12, lines 20-28). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ouzounidis and Kirkpatrick to retry transmission of the SMS message after the specified time period, as taught by O'Neil, in order to continue monitoring to determine when the mobile telephone becomes available.

### ***Response to Arguments***

9. Applicant's arguments filed 6/17/10 have been fully considered but they are not persuasive.

Applicant submits that the 112 rejection applied to claims 1 and 3-12 made in the previous office action have been overcome with the current amendments made to the claims. However, the claims are still indefinite for the reasons set forth above.

Applicant's also submits that the combination of Ouzounidis and Kirkpatrick does not teach the first step is activated by determining for time delay: a) when the state is not present, a first value (T1); and b) when the state is present, a second value (T2) and, if needed, without reaction from the mobile telecommunication network after expiration of T2, a third value (T3). These newly added limitations contain 112 issues



and are indefinite as indicated above. Therefore the rejections made with respect to prior art have been made under the broadest reasonable interpretation of the claim language.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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